## REMARKS

Claims 1-4, 12-13 and 33-34 are pending.

*Double Patenting*

Claims 1-4, 12-13 and 33-34 were rejected under the judicially-created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 14 and 16 of U.S. Patent 5,753,491 (the '491 patent). Applicants traverse.

The statement in the Office Action that the pending claims "encompass immortal human multipotent CNS neural stem cells, as claimed in '491" (page 2) is irrelevant to establishing a case of prima facie obviousness because no evidence is cited in the Action that it would be obvious isolate cholera-toxin negative (ChTx-) multipotent cells (i.e., Applicants' claimed invention) from a neuro-glial cell line as claimed in the '491 patent. Lacking evidence that one of ordinary skill in the art would have been motivated at the time Applicants' invention was made to modify the cell lines of the '491 patent and to isolate multipotent cells as claimed in this application, no prima facie case of obviousness is established.

Withdrawal of the double patenting rejection is requested.

*35 U.S.C. 102 – Novelty*

A claim is anticipated only if each and every limitation as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is claimed. See *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claims 1-4, 12-13 and 33-34 were rejected under Section 102(e) as allegedly anticipated by Major et al. (U.S. Patent 5,753,491). Applicants traverse.

The statement in the Office Action that the pending claims "encompass Major's immortal human multipotent CNS neural stem cell line" (page 3) is irrelevant to proving anticipation because no evidence is cited in the Action that Major et al. disclose an isolated cell line consisting of "immortal multipotent cells which are ChTx- and have the potential to differentiate toward neuronal cells or glial cells."

The '491 patent does not teach that the multipotent cells utilized by Applicants and claimed here are cholera-toxin negative (ChTx-) cells. The allegation in the Action that the '491 patent's "multipotent neural stem cells are inherently ChTX negative, by definition" (page 3) is incorrect. Multipotent stem cells can be either cholera-toxin negative or cholera-toxin positive. Therefore, cholera-toxin negative (ChTx-) status is not an inherent characteristic of multipotent stem cells. "Inherency . . . may not be established by probabilities or possibilities." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991), quoting *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (C.C.P.A. 1981). The burden is on the Patent Office to cite evidence that the allegedly inherent limitation is necessarily present in the prior art reference, not on Applicants to prove otherwise. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999).

Claims 1-4, 12-13 and 33-34 were rejected under Section 102(e) as allegedly anticipated by Weiss et al. (U.S. Patent 5,750,376). Applicants traverse.

The '376 patent does not teach that the multipotent cells utilized by Applicants and claimed here are cholera-toxin negative (ChTx-) cells. Multipotent stem cells can be either cholera-toxin negative or cholera-toxin positive. Therefore, cholera-toxin negative (ChTx-) status is not an inherent characteristic of multipotent stem cells. "Inherency . . . may not be established by probabilities or possibilities." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991), quoting *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (C.C.P.A. 1981). The burden is on the Patent Office to cite evidence that the allegedly inherent limitation is necessarily present in the prior art reference, not on Applicants to prove otherwise. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999).

Withdrawal of the Section 102 rejections is requested because all limitations of the claimed invention are not disclosed by the cited references.

*Conclusion*

Having fully responded to all of the pending rejections, Applicants submit that the claims are in condition for allowance and earnestly solicit an early Notice to that effect. The Examiner is invited to contact the undersigned if any further information is required.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By: _____

Gary R. Tamigawa
Reg. No. 43,180

901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100